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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,769	08/21/2003	Yoshio Honda	Q77075	6885

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EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT	PAPER NUMBER
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2627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/644,769

Applicant(s)

HONDA, YOSHIO

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-26 is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 30, 2007 has been entered.

Claim Status

Claims 1-19 and 21-26 are currently pending.

Claim 20 has been voluntarily canceled by the Applicant.

Foreign Priority

Receipt is acknowledged of papers submitted September 26, 2003, under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-5 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by the Miyazaki (JP 2002-117644 A).

As per claim 1, the Miyazaki (JP 2002-117644 A) discloses a recording medium cartridge comprising: a cartridge case (1); a recording medium (e.g., tape (3) wound around tape reel) housed in the cartridge case (1); and a cartridge memory (11) comprises an IC chip and an antenna (one of the antennae 12, which are separate from the chip (11) by being on another chip board, or spaced from the chip (11) by material (10a) as seen in Figure 3) electrically connected to said IC chip (11); and wherein said antenna (12) is spaced apart from said IC chip (11) - (one of the antennae 12, which are separate from the chip (11) by being on another chip board, or spaced from the chip (11) by material (10a) as seen in Figure 3); said IC (11) is formed on an IC chip board (10a) and the antenna (12) is spaced apart from the IC chip board (10a) (e.g. the antenna mounted on a separate underlying portion (10b)).

As per claims 2, 3 and 4, 5, the product by process limitations in these claims (e.g., “wherein said antenna is a printed antenna” (i.e., formed by printing) “said antenna is printed with a conducting paste,” “printed,”) are directed to the product *per se*, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17(footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessman*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*; 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final structure of the product “gleaned” from the process limitations or steps, which must be determined in a “product by process” claim, and not the patentability of the process limitations. Moreover, an old or obvious product produced by a new method is not a

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patentable product, whether claimed in "product by process" claims or not. Note that the applicant has the burden of proof in such cases, as the above case law makes clear.

Additionally, as per claims 4, 5, the antenna (12) is on a surface of said cartridge case (1) (e.g., interior surface of case).

As per claims 10-14 (and also claims 15-18, rejected, *infra*), wherein said antenna (12) is arranged at a corner inside said cartridge case (1) - see FIG. 1 and FIG. 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazaki (JP 2002-117644 A) in view of Tanimura et al. (JP 10-214477 A).

See the discussion of Miyazaki (JP 2002-117644 A), *supra*.

As per claims 15-18, see the rejections of claims 10-14, *supra*,

As per claims 6-9, Miyazaki (JP 2002-117644 A) does not expressly disclose wherein the antenna is overcoated, or as per claim 19, wherein the cartridge comprises a plurality of said antennas or IC chips.

Such antenna overcoatings and/or wherein the cartridge comprises a plurality of said antennas or IC chips are notoriously old and well known and ubiquitous in the art; as just one

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example, Tanimura et al. (JP 10-214477 A) is cited to show an analogous tape cartridge having an analogous IC and antenna affixed to the cartridge, wherein the antenna is overcoated by layers (12-15) individually, or collectively and as per claim 19, wherein the cartridge memory comprises a plurality of said antennas or IC chips (e.g., 20a, 20b).

Given the express teachings and motivations, as espoused by Tanimura et al. (JP 10-214477 A), it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the antenna of Miyazaki (JP 2002-117644 A) as being overcoated, as per claims 6-9, and/or wherein, as per claim 19, wherein the cartridge comprises a plurality of said antennas or IC chips, as is expressly disclosed and suggested by Tanimura et al. (JP 10-214477 A).

The rationale is as follows: one of ordinary skill in the art would have been motivated to provide the antenna of Miyazaki (JP 2002-117644 A) as being overcoated, as per claims 6-9, and/or wherein, as per claim 19, wherein the cartridge comprises a plurality of said antennas or IC chips, as is expressly disclosed and suggested by Tanimura et al. (JP 10-214477 A) in order to adequately reinforce the antenna and/or protect it by adding overcoating layers, and to further provide increased recording capacity by providing multiple IC memories, as discussed and suggested by Tanimura et al. (JP 10-214477 A).

Response to Arguments

Applicant's arguments filed November 30, 2006 have been fully considered but they are not persuasive.

The Applicant states at page 7 of the Response filed on November 30, 2006:

The subject matter of claim 20 has been incorporated into claim 1 and claim 20 has been canceled. Claim 1 recites a recording medium cartridge which includes, among other things, an antenna spaced apart from an the IC chip board on which the IC chip is formed. The Examiner asserts that the antenna 12 on wall 10b is spaced apart from the board 10a on which the IC chip 11 is formed. However, as shown in the figures, walls 10a and 10b are part of the same continuous substrate 10. Therefore, Miyazaki does not teach an antenna 12 which is spaced apart from the IC chip board, but only antenna 12 which are on the same substrate 10 as the IC chip 11.

As set forth in the rejection, *supra*, Miyazaki (JP 2002-117644 A) discloses an IC chip and an antenna (one of the antennae 12, which are separate from the chip (11) by being on *another* chip board, or spaced from the chip (11) by material (10a) as seen in Figure 3) electrically connected to the IC chip (11), wherein the antenna (12) is spaced apart from the IC chip (11) - (one of the antennae 12, which are separate from the chip (11) by being on another chip board, or spaced from the chip (11) by material (10a) as seen in Figure 3). The IC (11) is formed on an IC chip board (10a) and the antenna (12) is spaced apart from the IC chip board (10a) (e.g. the antenna mounted on (10b), which is separated or spaced from the IC and its underlying board).

Allowable Subject Matter

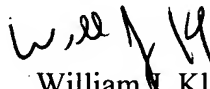
Claims 21-26 are tentatively considered allowable over the art of record, pending an updated search, amendments or arguments presented by the Applicant and considered by the Examiner in reply to this office communication.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


William J. Klimowicz
Primary Examiner
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WJK